

REMARKS/ARGUMENTS

Reconsideration of this application and entry of this Amendment are solicited. Claims 1-5, 7 and 9-15 will be active in the application subsequent to entry of this Amendment.

It is proposed to amend claims 1 and 2 in order to more particularly point out and distinctly claim that which applicants regard as their invention and to respond to issues raised in the outstanding Official Action.

In items 62-64 of the Action, claim 2 is criticized, the examiner asserting that the term "biodegradable" is indefinite. In fact, it is fully explained in the description of the invention, for instance at page 7. In order to advance examination of this application, claim 2 has been amended to incorporate this information directly from claim 7. Basis for this amendment will be apparent from the above comments.

It is also proposed to incorporate the subject matter of claim 8, namely an anchor coat layer disposed between plastic substrate (A) and the inorganic thin film (B), into claim 1. With this amendment consequential changes have been made in the dependencies of claims 9, 12 and 14.

It is submitted that these changes to the claims advance the examination of this application and for this reason alone this Amendment should be entered.

The balance of the Official Action relates to a series of prior art-based rejections. With the incorporation of claim 8 into claim 1 the rejections stated in items 22-26, 27-31, 52-56 and 57-61 are no longer pertinent. Applicants will focus on the primary combination of references, namely Takahashi et al in view of Kajimaru et al.

In Takahashi, the (II) gas barrier resin film layer is produced, the (III) inorganic oxide thin film layer is formed on it and the (Ib) primer layer is formed thereon. This laminate is attached to the (I) microporous resin film base layer. This means that Takahashi's laminate is composed of (Ib) primer layer/(III) inorganic oxide thin film layer/(II) gas barrier resin film layer and (I) microporous resin film base layer, they are prepared separately and are attached to each other by lamination or adhering by using a primer. At column 6, lines 48-54, Takahashi states that "The gas barrier resin film (II) may be adhered to the stretched microporous resin film base layer (I) by co-extruding a resin for the gas barrier resin film (II) and a filler-containing resin for the base layer (I) in producing the base layer (I), followed by stretching to produce a laminate of

the base layer (I) with the gas barrier resin film (II), or by using the above-mentioned primer (Ib).".

Namely, the (II) gas barrier resin film layer must already be present as the shape of film which can be subjected to formation of the (III) inorganic oxide thin film layer. Therefore, in Takahashi, there is no concept or suggestion that the (II) gas barrier resin film layer is prepared by coating method using a coating solution of polyester.

On the other hand, Kajimaru teaches an aqueous dispersion of polyester resin for a coating material. There is no intention to produce a film using the aqueous dispersion of polyester resin for a coating material.

Therefore, these references cannot be combined because they are completely different from each other. If the rejection insists that Kajimaru's aqueous dispersion of polyester resin can be used for a gas barrier resin film (II) of Takahashi, then applicants should like to know how the film can be produced using an aqueous dispersion of polyester without any support material. Attempts to form a film from an aqueous dispersion of polyester in an extruder (the usual molding machine for preparation of sheet and film) will not be successful – this will be readily apparent to any one of ordinary skill in the art (normally solids such as plastic pellets or particles are extruded).

Counsel notes the examiner's findings must be based on substantial evidence, i.e. some concrete evidence in the record. *See In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). ("[T]he Board cannot simply reach conclusions based on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

As seen from Kajimaru, in order to form a coat using an aqueous dispersion of polyester, a solid support is absolutely required for coating with the aqueous dispersion of polyester.

However, in Takahashi, there is no support present in the preparation of gas barrier resin film (II).

Therefore, the rejection is based upon hindsight after having knowledge of the present invention.

An obviousness rejection must rest on a sound factual basis with these facts being deduced without hindsight reconstruction of the invention from the prior art. The Examiner may

not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption, or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). One cannot employ hindsight by using the applicant's own disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988).

As for the secondary references of US 5,491,018 and US 5,804,300, these references do describe an anchor coat layer. However, in both references, the anchor coat layer is not provided between the base layer and an inorganic layer. The layer structure is different from that of the present invention.

The combination of the Takahashi et al and Kajimaru et al patents do not render obvious the claimed invention because all of the limitations of the independent claims are not fairly taught or suggested by the cited patents. Moreover, claims depending from those independent claims are also not made obvious by the citations because the limitations of an independent claim are incorporated into their dependent claims. MPEP §2143.03.

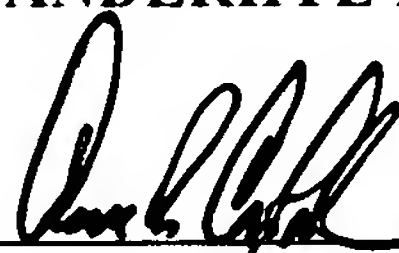
Withdrawal of the rejections are requested because the claimed invention would not have been obvious to the ordinary skilled artisan at the time applicants made their invention.

Having responded to all of the pending rejections contained in the Official Action, applicants submit that their claims are in condition for allowance and earnestly solicit an early notice to that affect. The examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



Arthur R. Crawford
Reg. No. 25,327

ARC:eaw
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100